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O M (Sam) Zaghmout
Bio Intellectual Property Service (Bio Ips)
8509 Kernon Ct
Lorton, VA 22079

EXAMINER

LAUX, JESSICA L

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/553,290
Filing Date: November 17, 2005
Appellant(s): GIBSON, RODNEY MARK

Sam Zaghmout
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/05/2010 and the supplemental appeal brief filed 10/29/2010 appealing from the Office action mailed 4/26/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-13,16 are rejected;

Claims 14,17,18 are objected to as being dependant on a rejected base claim, but otherwise allowable.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,966,956	MORRIS	10-1999
20060185262	ABLER	8-2006
20030051417	CIOTTI	3-2003
WO9802626	KALINOWSKI	1-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-8, 11-13, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciotti (20030051417).

1. Ciotti discloses a building construction having a main portion (generally 10, including 16, 14), a roof portion (25), and a floor portion (24), the roof portion and the floor portion each being attached to the main portion by way of a respective pivot connection or connections (as seen in figures 1b-d; paragraphs 0024-0025), the building construction being formed such that the main portion, the roof portion and the floor portion can be arranged with respect to one another such that the building construction is substantially in the shape of a box-like freight container in which the roof portion and/or the floor portion provide(s) structural integrity, the structural integrity

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being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle with a normally loaded freight container on top of it, in either case without causing structural damage to the building construction, and wherein the building construction can be, after being freighted to a desired site, assembled by swinging the roof portion out from the main portion, and by swinging the floor portion out from the main portion, not necessarily in that order, but in each case by way of the pivot connections, such that the roof and floor portions become at least part of the roof and floor of the building construction respectively when the building construction is installed on site (paragraphs 0006, 0023-0025).

2. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures).

5. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions, and wherein the floor portions can be outside of the respective roof portions when the building construction is in a disassembled state (as seen in the figures).

6. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the

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first mentioned roof and floor portions, and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard freight container (as seen in the figures; paragraphs 0006, 0023).

7. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO freight container (paragraph 0023).

8. A building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), and wherein the building construction is, when in a disassembled state, substantially in the shape of a standard ISO 40 foot freight container (paragraph 0023).

11. A building construction according to claim 1, including framing and panels wherein the panels can be fitted between parts of the framing to create internal and/or external walls (as seen in the figures; paragraphs 0027-0029).

12. A building construction according to claim 1, wherein the structural integrity is such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent four corners of the building construction without causing structural damage to the building construction (paragraphs 0006, 0023; where there is a

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presumption of a workable device and where one of ordinary skill in the art would upon reading Ciotti immediately recognize that the device is not intended to be damaged).

13. A building construction according to claim 1, wherein the building construction is at least partially clad when in a disassembled state (as seen in the figures, clad at least by elements 12, 14).

16. A building construction according to claim 1, wherein the building construction is certified as a shipping container for use on container ships (paragraphs 0004-0005).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of Abler (20060185262).

3. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), but is silent regarding locking means for the floor and wall portions such that they can each be locked in a substantially vertical orientation when the building construction is in a disassembled state for freighting.

Abler discloses a building construction having hinged wall portions for forming an expanded floor where in a closed position the building is an ISO shipping container, and further discloses that the portions have locking means for freighting (paragraph 0016).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the building of Ciotti to have the locking means as disclosed by Abler to provide a secure container for shipping.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of Morris (5966956).

4. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures), but does not disclose that the roof portions can be outside of the respective floor portions when the building construction is in a disassembled state, but instead discloses that they are inside the floor portions.

Morris discloses a building construction have expandable floor and roof portions where when in a non-expanded position resemble a shipping container. Morris further discloses that the roof portions can be outside the respective floor portions when the building construction is in a disassembled state (figure 3).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to pursue know techniques of sidewall placement (such as that disclosed by Morris) and employ them to achieve the predictable results of a floor and roof

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portions that expand. Further it is noted that whether the roof portions are above or under the floor portions in the disassembled state appears to be a mere matter of obvious design choice as applicant has not disclose that either position provides an advantage, or solves a stated problem, but rather discloses either embodiment to be acceptable. As the prior art clearly discloses either position to be know it would have been obvious to pick one for applicants own invention.

Claims 9-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciotti (20030051417) in view of WO9802626.

9-10, 12. Ciotti discloses the building construction according to claim 1, wherein there is a second roof portion and a second floor portion arranged and able to function in similar fashion to the first mentioned roof and floor portions but at an opposite side of the main portion to the first mentioned roof and floor portions (as seen in the figures),

But does not disclose a removable corner protector arranged over at least part of an external edge or along a different external edge of the disassembled construction to provide a measure of protection and/or strength to the construction when it is being transported.

WO9802626 discloses foldable, portable building construction comprising removable corner protector 26 to aid in moving the building when being transported (as seen in figure 16).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the building construction of Ciotti do include the corner protectors of WO9802626 to aid in safely and efficiently transporting the construction,

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such that the building construction can, when in a disassembled state, be picked up by the crane at or adjacent four corners of the building construction without causing structural damage to the building construction.

(10) Response to Argument

Response to Arguments

Appellant's arguments have been fully considered but they are not persuasive.

Regarding appellant's arguments of the rejection under Ciotti:

The limitation that "the structural integrity being such that the building construction can be picked up by a crane, and/or arranged in a freight vehicle..." is an intended use recitation as it clearly imparts the intent to use the structure in a manner that it would be picked up by a crane or arranged in a freight vehicle. The limitations of being picked up by a crane or arranged in a freight vehicle do not themselves impart structure to the claimed building construction but rather impart a capability of an intended use of the building.

The term "structural integrity" does not impart any structure to building, rather it defines a function of the building to be capable of the intended use. Nowhere in the claim or specification does applicant disclose or suggest any novel or specific structural elements or features that enable the building to have the claimed structural integrity, thereby leaving one skilled in the art to wonder what applicant's invention possesses that makes it capable of the claimed structural integrity that the prior art of Ciotti does not have. The fact that a prior art reference does not explicitly state that it is capable of a certain use without damage or destruction of the device does not render that prior art

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device incapable of that certain use. It would be immediately recognizable to a person of ordinary skill in the art that the device be capable of withstanding transportation without damage as Ciotti clearly discloses the device to be a cargo shipping container transported via a cargo ship. As best understood from applicant's disclosure and claims the prior art structure of Ciotti discloses the claimed invention in as much detail as applicant intends for the metes and bounds of the claimed structure of the device and therefore Ciotti discloses a structure equivalent to applicant's and capable of being used in the same manner with same structural integrity (where it is understood that the structural integrity of applicant's invention is derived from the claimed components and their assembly and Ciotti discloses the claimed invention).

Applicant's argument that the claim limitation of "impart sufficient structural integrity to withstand crane lifting and/or stacking" is clearly a structural difference is not persuasive. A structural difference must result in structure that is different. See MPEP 2114. Saying that something is able to withstand a certain force does not necessarily impart specific structure and in this case certainly does not. Therefore absent any showing by applicant that the claimed structural integrity is derived from specific structural elements that impart said structural integrity and that the prior art of Ciotti does not have those features the claim is anticipated by Ciotti, where Ciotti is capable of the claimed use because it has the same structure as applicant's claimed invention.

Just as applicant's invention is capable of the claimed use, there being no differences to the structure of applicant's invention and that of Ciotti, so then is Ciotti capable. Absent any showing that one construction is capable of something that a

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similar construction is not capable of it is to be understood that two similar constructions are capable of the same uses whether expressly disclosed as capable of that use or not.

Applicant's argument that Ciotti could be constructed with various manners making it incapable of the claimed use is mere conjecture and not persuasive. As applicant has not specified what structure of the presently claimed invention imparts that structural integrity or how the structure achieves that integrity it would be mere conjecture to say that Ciotti is not capable of the claimed use because they are similar constructions and Ciotti clearly anticipates the claimed structure.

Applicant's argument that there is nothing in Ciotti that renders it capable of the claimed structural integrity is not persuasive for the reasons noted above.

It is noted that paragraph 0030 of Ciotti discloses that the construction could be a multi-level construction with one container stacked upon another container. Presumably one container would have to somehow be transported and lifted to achieve a stacked configuration. While Ciotti does not expressly disclose the how of the configuration it would not be without sound reasoning that the container has the structural integrity to be moved and lifted into position or be capable of a supporting/supported relationship with another container.

Regarding Appellant's arguments of the rejection under Ciotti in view of Abler:

Appellant's argument's amount to mere conjecture speculation of supposed structure. Abler clearly discloses an ISO shipping container configured for other uses and having swing down floor portions where the swing down portion includes a locking

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mechanism when in the vertical position. One of ordinary skill in the art has good reason to pursue known options within his/her technical grasp. Therefore it would not be beyond the ordinary and common sense of one skilled in the art, upon review of the Abler reference to pursue a locking mechanism to provide additionally security to the structure for shipping and transportation.

Regarding Appellant's arguments of the rejection under Ciotti, in view of WO 9802626:

In response to Appellant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, WO 9802626 clearly discloses a teaching and motivation for providing corner protectors.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jessica Laux

/Eileen Lillis/

Supervisory Patent Examiner, Art Unit 3635

Conferees:

Bill Katcheves

/Basil Katcheves/

Primary Examiner, Art Unit 3635

Eileen Lillis

Darnel Jayne /dj/